

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 2, 4, 6-15, and 33-54 are pending in this application. Claims 1 and 33-36 are independent claims. Claims 1, 2, 4, 6-15, and 33 - 36 are amended. Claims 3, 5, and 16 – 32 are canceled. Claims 37 – 54 are new.

Applicants acknowledge with appreciation the Examiner's indication that the drawings have been accepted by the United States Patent and Trademark Office (USPTO); that certified copies of the priority documents have been received; and that the references included in the Information Disclosure Statement filed January 29, 2004 have been considered.

Rejections under 35 U.S.C. §101

Claims 1-32 stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has incorrectly characterized the recording medium as storing **nonfunctional** descriptive material. The Manual of Patent Examining Procedure (MPEP) provides guidance on the difference between “nonfunctional descriptive material” and “functional descriptive material”. In particular, MPEP § 2106.01 states the following.

In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited music, literary works and a compilation or mere arrangement of data. (emphasis added).

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Accordingly, Applicants respectfully submit that a “a computer-readable medium having a data structure for managing reproduction duration of still pictures” as recited in independent claim 1 is a recording medium storing **functional** descriptive material.

MPEP §2106.01(I) further states, regarding **functional** descriptive material, that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” Accordingly, because the computer readable medium recited in claim 1 includes a data structure having a navigation area directing reproduction of first and second files stored in a separate data area, claim 1 is clearly directed towards patentable, statutory subject matter.

In light of the above, Applicants respectfully request that the rejections of claims 1-32 under 35 U.S.C. §101 be withdrawn.

Rejections Under 35 U.S.C. § 103 – Okada in view of Kanazawa et al.

Claims 1-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,122,436 (“Okada”) in view of U.S. Patent No. 6,580,870 (“Kanazawa et al.”). This rejection is respectfully traversed.

Initially, Applicants note that claim 1 has been amended to read “a navigation area storing at least one playlist and at least one clip information file separately within the navigation area.” The Examiner submits that the path management information corresponding to the

playlist and clip information files described in Okada are not stored separately on a computer-readable medium and thus constitute a different recording medium from that claimed in claim 1.

The Examiner references figure 9(a) of Okada to describe Okada's path management information. According to the Examiner on page 4 of the office action, the "PGC" is equivalent to a playlist file with the "cell" equivalent to a playitem. The examiner also states on page 5 of the office action that the "MANAGEMENT INFORMATION FILE" illustrated in figure 9(a) is equivalent to a clip information file with the "VOB" table acting as the entry point maps. Figure 9(a) therefore describes a path management scheme where the playlist (PGC) is embedded within a clipfile (MANAGEMENT INFORMATION FILE) which is different from that claimed in claim 1. Claim 1 claims "a navigation area storing at least one playlist and at least one clip information file separately within the navigation area..."

The path management information taught in Kanazawa is also different from that being claimed in claim 1. Kanazawa teaches

The video object set (VOBS) constituting a title includes a large number of video objects called cells (cell #1, cell #2, . . .). Each cell is composed of a large number of video object units, with **a navigation pack (NAVI) at the head**. That is, the video object units from one navigation pack to the next navigation pack constitute a single cell (or a video object). The navigation pack is included in video data units of one GOP or two GOPs (0.5 sec. to 1 sec). **Each navigation pack is management information to control the reproduction of the corresponding video object** and is composed of a disk search information (DSI) pack and presentation control information (PCI) pack. The DSI pack is used as search information for the reproduce start address in special playback, such as fast-forward or rewind. The PCI pack is used to change angles in multiangle playback or to display highlight information for executing a navigation command (e.g., a button command) according to the instruction given by the user. In the third embodiment, a URL indicating the HTML contents related to an image of the corresponding video object is embedded in an empty area of a DSI pack or PCI pack.

(See Kanazawa, column 13, lines 29 to 49). This teaching is different from that being claimed in claim 1. Claim 1 claims a computer-readable medium with a “data area storing presentation data” and “a navigation area storing at least one playlist and at least one clip information file.”

Since neither Okada nor Kanazawa teach “a navigation area storing at least one playlist and at least one clip information file separately within the navigation area...” alone or in combination, then it would not have been obvious to one skilled in the art to have arrived at this feature based on the references cited.

In light of the above arguments, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 1 and all claims which depend thereon be withdrawn.

For similar reasons, the Applicant respectfully requests that the 35 U.S.C. §103(a) of the remaining independent claims and all claims which depend thereon be withdrawn.

Rejections Under 35 U.S.C. § 103 – Okada in view of Kanazawa et al. and further in view of
Monahan

Claims 35 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Kanazawa et al., and in further view of U.S. Patent Publication No. 2004/0141436 (“Monahan”). This rejection is respectfully traversed.

Claim 35 is amended to read “...the controller configured to control the optical recording device **to record at least one playlist and at least one clip information file separately** on the recording medium.” The feature is not disclosed or taught in any of the above cited references, therefore it would not have been obvious to one skilled in the art to arrive at this feature even if

For reasons similar to those stated above, the Applicant respectfully request that this rejection of claims 36 under 35 U.S.C. §103 based on Okada, Kanazawa, and Monahan be withdrawn as well.

Double Patenting Rejection

Claims 1-36 stand provisionally rejected on the ground of nonstatutory, obviousness-type double patenting as being unpatentable over claims 1-34 of copending App. No. 10/766,238, which has at least one Applicant in common with the present application.

Claims 1-36 stand provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/766,238. Applicants acknowledge this provisional rejection, and will take the appropriate steps to address this rejection once the claims in the present application and the claims in copending application No. 10/766,238 are indicated as including allowable subject matter since this provisional rejection is based on claims that may change. Further, Applicants respectfully request the Examiner reconsider this rejection in view of the amended claims. Moreover, Applicants respectfully submit claims 1-36 of the current application and claims 1-34 of copending Application No. 10/766,238 are patentably distinct, as detailed below.

Applicants submit that to establish a *prima facie* case of nonstatutory-type double patenting rejection, the Examiner must first identify the inventions claimed in the claims under consideration and in the reference patent claims. The Examiner must then establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person having ordinary skill in the art.

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Based on U.S. case law, the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a); the burden of proof would then shift to the applicant to rebut the *prima facie* case. See *In re Longi*, 225 USPQ 645, 651 (Fed. Cir. 1985).

On page 2 of the Office Action, Examiner states that "although the conflicting claims are not identical, they are not patentably distinct from each other." More specifically, Examiner states that "both inventions relate to managing reproduction of images and related data associated with the images with the related data being graphic data and subtitle data." Further, Examiner states that "both inventions also relate to multiplexing the images and the related associated data into transport stream and packetized elementary streams." However, as an example, Applicants submit that claim 1 of the current application appears to be patentably distinct from claim 1 of the copending application. In particular, independent claim 1 of the copending Application No. 10/766,238 recites *inter alia* **"the playitem including a stream indication field indicating the data streams associated with the playitem"** while independent claim 1 of current application No. 10/766,193 recites *inter alia* **"the playitem indicating at least one of the still picture units to reproduce and providing duration information for display of the still picture in the still picture unit."** Therefore, it is not possible to read on both claims simultaneously. The duration information, or lack thereof, determines which claim is read upon. Therefore, at the very least, at least some of claims 1-36 of the current application and at least some of claims 1-34 of copending Application No. 10/766,238 are patentably distinct from each other. Should Examiner still find certain claims to be patentably indistinct between the two

compending applications, Applicants respectfully submit that Examiner specify and explain, with respect to the obviousness standards described above, those claims of the compending applications that Examiner alleges to be patentably indistinct. Therefore, Applicants respectfully request that the provisional rejection of claims 1-36 on the ground of nonstatutory, obviousness-type double patenting as being unpatentable over claims 1-34 of compending App. No. 10/766,238 be withdrawn.

NEW CLAIMS 37-54

Applicants submit that the new independent caims 37-54 are similar to dependent claims 6-15 and thus, is believed to be allowable for reasons similar to those mentioned above.

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) hereby petition(s) for a one (1) month extension of time for filing a reply to the Office Action and submit the required \$120.00 extension fee herewith.

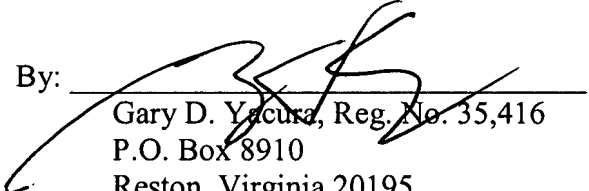
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By: _____


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